

REMARKS

Applicant hereby traverses the outstanding objection and rejections, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 21-44 are pending in this application.

Objection to the Specification

The specification stands objected to for informalities listed on page 2 of the Office Action. In response, Applicant has amended the specification to delete the duplicate heading and paragraph. Each identified instance has been corrected with a corresponding amendment. No new matter has been entered. Thus, Applicant believes that the objection to the specification has been overcome, and that this objection should be withdrawn.

Doubling Patenting

Claims 21-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,681,089 B2.

In response to the rejection, Applicant respectfully submits that a prima facie case of obviousness has not been established.

A double patenting rejection of the obvious-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. § 103” except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967) as cited in M.P.E.P. § 804(II)(B)(1). Therefore, any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. § 103(a) rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are employed when making an obvious-type double patenting analysis. See M.P.E.P. § 804(II)(B)(1). These factual inquiries are summarized as follows: (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (B) Determine the

differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue; (C) Determine the level of ordinary skill in the pertinent art; and (D) Evaluate any objective indicia of non-obviousness.

The conclusion of obvious-type double patenting is made in light of these factual determinations. Any obvious-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims, i.e. a claim in the recited application compared to a claim in the current application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the recited application. See M.P.E.P. § 804(II)(B)(1).

The rejections detailed in the Office Action do not detail all of the differences between the claims of the recited application as compared with the current application. The Office Action also does not provide any reasons why one skilled in the art would conclude that the claims of this current application are obvious in view of the claims of the recited applications. The Office Action merely states that the claims are not patentably distinct without providing the required rationale. The Office Action states that some of the differences are functional limitations and therefore obvious. However, Applicant asserts that this is insufficient rationale for concluding obviousness. Therefore, Applicant respectfully asserts that the rejection is invalid, and that the rejection should be withdrawn.

Rejection under 35 U.S.C. § 103

Claims 21-22, 27-29, 31-34, 36, 38, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hiro et al. ('898, hereinafter Hiro).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

The Office Action admits that Hiro does not teach that the packaging member is used in a toner cartridge or that the developing unit includes a toner hopper that is sealed by a sealing strip. The Office Action attempts to cure this deficiency by relying upon Official Notice to teach such limitations. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Applicant notes that independent claims 21 and 32 do not include the words “toner hopper”, and independent claims 38 and 41 do not include the words “toner hopper that is sealed by a sealing strip”.

Claim 21 defines a toner cartridge having a removable cover attachable to said photoconductor drum wherein said removable cover isolates said photoconductor drum from at least one other component of said toner cartridge to reduce charges associated with said photoconductor drum. Hiro does not disclose at least these limitations. The packaging member of Hiro is not disclosed as being arranged to isolate the photosensitive member from at least one other component to reduce charges. Instead, Hiro discloses having the packaging member be able to generate a frictional charge that is same polarity as the photosensitive member, see column 4, lines 27-33. This prevents charge memory from occurring when the packaging member is removed from the photosensitive member. Nothing in Hiro discloses that the packing member isolates the photosensitive member from at least one other component. The Official Notice is not relied upon as teaching this limitation. Thus, the combination of Hiro and Official Notice does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 21 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 32 defines a method that includes isolating said selected component from other components of said toner cartridge with a removable cover to bleed off static charge associated with said selected component. Hiro does not disclose at least these limitations. Hiro does not disclose isolating the photosensitive member from other components with the packaging member to bleed off static charge. Instead, Hiro discloses having the packaging member be able to generate a frictional charge that is same polarity as the photosensitive member, see column 4, lines 27-33. This prevents charge memory from occurring when the packaging member is removed from the photosensitive member. Nothing in Hiro discloses that the packing member isolates the photosensitive member from at least one other

component. The Official Notice is not relied upon as teaching this limitation. Thus, the combination of Hiro and Official Notice does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 32 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 38 defines a tone cartridge having a removable cover wherein said removable cover isolates said organic photoconductor from at least one of said primary charge roller, cleaning blade, developer roller and transfer roller and bleeds off static charge associated with said organic photoconductor. Hiro does not disclose at least these limitations. The packaging member of Hiro is not disclosed as being arranged to isolate the photosensitive member from at least one of a charge roller, a cleaning blade, a developer roller and a transfer roller, and bleeds off static charge. Instead, Hiro discloses having the packaging member be able to generate a frictional charge that is same polarity as the photosensitive member, see column 4, lines 27-33. This prevents charge memory from occurring when the packaging member is removed from the photosensitive member. Nothing in Hiro discloses that the packing member isolates the photosensitive member. The Official Notice is not relied upon as teaching this limitation. Thus, the combination of Hiro and Official Notice does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 38 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 22, 27-29, 31, 33-34, 36, and 40 depend from base claims 21, 32, and 38, respectively, and thus inherit all limitations of their respective base claims. Each of claims 22, 27-29, 31, 33-34, 36, and 40 sets forth features and limitations not recited by the combination of Hiro and Official Notice. Thus, the Applicant respectfully asserts that for the above reasons claims 22, 27-29, 31, 33-34, 36, and 40 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Official Notice

In the rejection of claims 21-22, 27-29, 31-34, 36, 38, and 40, the Office Action takes Official Notice to three elements, namely (1) that it is old and well known in the art to provide various image forming components in a process or toner cartridge, (2) that it is further well known that components in the toner cartridge may include a photosensitive member, primary charger, cleaning unit, developing unit, and the like, and (3) that it is well known to provide a sealing strip to seal a toner hopper. Under Rule 37 C.F.R. § 1.104(d)(2),

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the Examiner is hereby requested to provide and make of record an affidavit setting forth his data as specifically as possible for each of the three assertions. Alternatively, under M.P.E.P. § 2144.03, the Examiner is hereby requested to cite a reference or references in support of each assertion. Otherwise the rejection of claims 21-22, 27-29, 31-34, 36, 38, and 40 should be withdrawn.

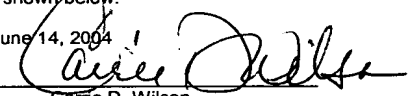
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10013566-4 from which the undersigned is authorized to draw.

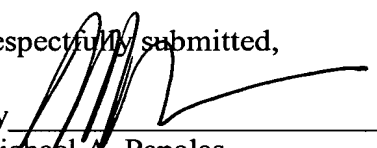
Dated: June 14, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734908US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: June 14, 2004

Signature: 
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Respectfully submitted,

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